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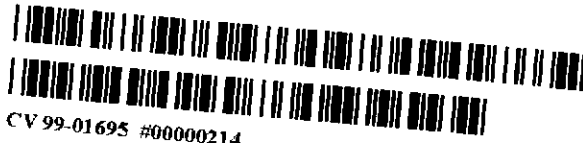
CC TO JUDGE KN

THE HONORABLE MARSHA PECHMAN

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BY  AT SEATTLE
CLERK U.S. DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON DEPUTY


CV 99-01695 #00000214

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

AMAZON COM, INC ,

Plaintiff,

v

BARNESANDNOBLE COM, INC , and
BARNESANDNOBLE COM LLC,

Defendants

NO C99-1695P

AMAZON COM'S OPPOSITION TO
BARNESANDNOBLE COM'S MOTION
TO FILE SUPPLEMENTAL CLAIMS
CONSTRUCTION BRIEF

I. INTRODUCTION

Amazon com and Barnesandnoble com negotiated a comprehensive pretrial schedule, including a schedule for consideration of claims construction. The parties' schedule specifies the briefs that will be permitted and the dates by which they must be filed. The latest agreed revision of this comprehensive schedule was adopted in the Court's order entered May 21, 2001.

OPPOSITION TO MOTION TO FILE
SUPPLEMENTAL CLAIMS
CONSTRUCTION BRIEF - 1

[24976-0219/SL013190 015]



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1 To reach agreement on the comprehensive pretrial schedule, each party was required to
 2 compromise In the end, the parties agreed upon a schedule that provided a fair hearing to both
 3 parties of the issues to be decided
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 5

6 Barnesandnoble com now asks the Court for an unwarranted advantage by allowing it to
 7 file, on the very day of the claims construction hearing, another brief and additional evidence to
 8 which Amazon com would not be permitted to reply This, however, is not encompassed by the
 9 mutually fair procedure negotiated by the parties and adopted by the Court
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14 Barnesandnoble com's claimed excuse for this belated, unauthorized filing does not
 15 justify permitting its proposed substantial change to the parties' agreed procedure The
 16 Barnesandnoble com proposal would also eliminate the core elements of the procedure
 17 Amazon com negotiated to obtain – that the briefing and submission of evidence regarding
 18 claims construction be completed well before the hearing in order to allow a fair chance to
 19 prepare, and that Amazon com be allowed to file the final brief on this issue
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27 Barnesandnoble com's actions echo its tactics during the preliminary injunction hearing,
 28 when each day brought additional new surprise contentions and evidence, rather than the issues
 29 and evidence it previously had identified in compliance with the Court's rules and scheduling
 30 order The Court should make clear that such litigation tactics are no longer acceptable, and
 31 deny the motion
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37 II. ARGUMENT

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 39 The parties repeatedly have negotiated and renegotiated the procedural schedule in this
 40 case in order to assure what both parties believed to be a fair consideration of the issues by the
 41 Court Since the outset, that procedure has included three briefs regarding claim construction –
 42 an opening brief by Amazon com, a brief by Barnesandnoble com, and a reply brief by
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1 Amazon com These three briefs were then followed, after a period of preparation, by the
 2 Court's hearing regarding claims construction See Supplemental Joint Status Report at 2-3
 3 (Feb 7, 2000), Stipulation Regarding Discovery and Pre-Trial Schedule (Sept 9, 2000), Order
 4 Granting Barnesandnoble com's Unopposed Motion Regarding Discovery and Pretrial Deadlines
 5 and Trial Date (May 14, 2001)
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10 Ignoring the parties' series of agreements, all adopted by the Court, Barnesandnoble com
 11 now seeks to deny much of what it negotiated to give Amazon com, the last brief on the subject
 12 of claims construction and a mutual exchange of evidence and arguments well in advance of the
 13 claim construction hearing
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18 Barnesandnoble com's sole claimed excuse for disregarding its prior agreement, several
 19 times made, is that it was unable to take its second depositions of Amazon com's inventors
 20 before it filed its claim construction brief This excuse is pretense It ignores that
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- 25 • Barnesandnoble com made no effort to obtain the inventor depositions for over a
 26 year and half, including over six months after the Federal Circuit rendered its
 27 opinion in this case (Chin Declaration¹ Ex A)
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 46 ¹ Declaration of Steven D Chin in Support of Barnesandnoble com's Motion for Leave
 47 to File its Supplemental Brief on Claims Construction ("Chin Declaration")

- When Barnesandnoble com decided to take the depositions of Amazon com's inventors shortly before its claim construction brief was due, it noticed all four inventors' depositions, together with the deposition of Amazon com's patent counsel, for exactly the same time and date, obviously anticipating that the depositions could not go forward as noticed² (*Id*)
- At no time during the process of scheduling the depositions did Barnesandnoble com ever suggest it needed to obtain the testimony of any of the witnesses before it filed its claim construction brief (*Id.* Exs B – P) To the contrary, just a few weeks earlier in the Joint Claim-Construction Statement of Amazon com and Barnesandnoble com at 2 (Aug 31, 2001), the parties had agreed

The parties believe that the claims of the '411 patent can be construed on the basis of the claims, specification, and prosecution history, and the ordinary meaning of the words used in the claims, without reference to extrinsic evidence (e g , witness testimony) except as necessary to establish the ordinary meaning of words to one of skill in the art of electronic commerce

² Barnesandnoble com must have known the deposition scheduling would take some time in that two of the deponents are no longer Amazon com employees, and one of the inventors is Jeff Bezos

- The depositions from which Barnesandnoble com proposes to use testimony were taken on September 28 and October 3, 12, 22, and 25. Thus, over *six weeks* have passed since Barnesandnoble com obtained the first of the testimony it now proposes to offer, the last of this deposition testimony was obtained over two weeks before Barnesandnoble com filed its motion seeking consent to belatedly supplement its brief.

In reality Barnesandnoble com had plenty of time to obtain whatever testimony it really wanted before it filed its brief, had time to make a timely application to use the testimony and still allow Amazon com the agreed-upon opportunity to file a reply to it, and had time to assure all this happened sufficiently before the hearing to allow a fair opportunity to prepare.

There are good reasons why Barnesandnoble com attempts to spring this material on Amazon com and the Court, and not have it carefully considered. Most obviously, the evidence Barnesandnoble com offers is, according to the repeated pronouncements of the Federal Circuit, of no legal consequence.

The testimony of an inventor and his attorney concerning claim construction is thus entitled to little or no consideration.

* * *

Nor may the inventor's subjective intent as to claim scope, when unexpressed in the patent documents, have any effect.

Vitronics Corp v Conceptronic, Inc., 90 F 3d 1576, 1583, 1584 (Fed Cir 1996). See also *Bell & Howell Document Management Products Co v Altek Systems*, 132 F 3d 701, 706 (Fed Cir 1997) ("testimony of an inventor and his attorney concerning claim construction is thus entitled to little or no consideration"), *Roton Barrier, Inc v. The Stanley Works*, 79 F 3d 1112,

1 1126 (Fed Cir 1996) (“an inventor’s ‘after-the-fact testimony is of little weight compared to
2 the clear import of the patent disclosure itself”)
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4
5 Last year the Federal Circuit once again explained that “an inventor is not competent to
6 construe patent claims,” and the reasons for the rule
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9 In *Markman*, we addressed the issue of litigation-derived inventor
10 testimony in the context of claim construction, and concluded that such
11 testimony is entitled to little, if any, probative value. We reasoned that an
12 inventor is not competent to construe patent claims for the following
13 reasons
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16 “[C]ommonly the claims are drafted by the inventor’s patent solicitor and
17 they may even be drafted by the patent examiner in an examiner’s
18 amendment (subject to the approval of the inventor’s solicitor). While
19 presumably the inventor has approved any changes to the claim scope that
20 have occurred via amendment during the prosecution process, it is not
21 unusual for there to be a significant difference between what an inventor
22 thinks his patented invention is and what the ultimate scope of the claims
23 is after allowance by the PTO.”
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26 *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379-80 (Fed. Cir. 2000) (citations omitted)
27 (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 985 (Fed. Cir. 1995) (en banc),
28 *aff’d*, 517 U.S. 370, (1996)).
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32 Barnesandnoble.com suggests that a different rule applies when an infringer rather than a
33 patent owner offers the inventor’s testimony. But, in that context, it equally is true, as the
34 Federal Circuit explained, that “it is not unusual for there to be a significant difference between
35 what an inventor thinks his patented invention is and what the ultimate scope of the claims is
36 after allowance by the PTO.” *Id.* Not surprisingly, given the illogic of such an argument in light
37 of the Federal Circuit’s precedent, that court has never suggested inventor testimony offered by
38 an infringer is any more competent to construe claims than other inventor testimony. Indeed,
39 the very decision cited by Barnesandnoble.com to support its argument (Barnesandnoble.com’s
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1 Supplemental Brief on Claims Construction at 2), *Hoechst Celanese Corp. v BP Chemical,*
 2 *Ltd.*, 78 F 3d 1575, 1580 (Fed Cir 1996), consistent with the cases discussed above, explains,
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 4 “*Markman* requires us to give no deference to the testimony of the inventor about the meaning
 5 of claims ”
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 9 Apart from its legal irrelevance, Barnesandnoble com’s proposed extrinsic evidence also
 10 is subject to impeachment The proposed evidence consists of sound bites taken out of context
 11 and based upon limited questioning These sound bites suggest meanings inconsistent with the
 12 witnesses’ actual beliefs about the patent It would be grossly unfair to permit
 13 Barnesandnoble com belatedly to offer such evidence in a manner that precludes the witnesses’
 14 from testifying as to their actual beliefs regarding the construction of the claims
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20 During the preliminary injunction hearing, Barnesandnoble com effectively used surprise
 21 evidence to preclude fair rebuttal in a procedure characterized by the Federal Circuit, during the
 22 oral argument of this case, as “swinging from the trees ” Not surprisingly, Barnesandnoble com
 23 wishes to continue that tactic The Court should not permit it
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28 The parties carefully negotiated a procedure for consideration of claim construction fair
 29 to both Barnesandnoble com should be held to the agreement it negotiated Its untimely
 30 decision to seek to place favorite snatches of deposition testimony before the Court does not
 31 justify changing the fair procedure the parties negotiated
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1 DATED this 15th day of November 2001

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3 **PERKINS COIE LLP**

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OPPOSITION TO MOTION TO FILE
SUPPLEMENTAL CLAIMS
CONSTRUCTION BRIEF - 8

[24976-0219/SL013190 015]

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CLERK U.S. DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
BY _____ DEPUTY

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

AMAZON COM, INC ,

Plaintiff,

Vs

BARNESANDNOBLE COM, INC , and
BARNESANDNOBLE COM, LLC,

Defendants

NO C99-1695P

CERTIFICATE OF SERVICE

I, William D Fisher, under penalty of perjury under the laws of the State of Washington,
hereby swear that on this 15th day of November 2001, I caused to be served a true and correct copy
of

(1) AMAZON.COM'S OPPOSITION TO BARNESANDNOBLE.COM'S MOTION TO
FILE SUPPLEMENTAL CLAIMS CONSTRUCTION BRIEF; and

(2) CERTIFICATE OF SERVICE

on counsel for defendants as follows

CERTIFICATE OF SERVICE - 1
[24976-0219/SL013190 139]

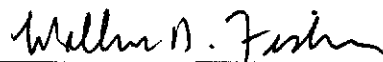
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